

Attorney Docket No. P1998J096

APR 26 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Alan G. Blahey et al.  
U. S. Serial No.: 09/806,873  
Filed: April 3, 2001  
For: Long Life Gas Engine Oil and Additive System

Group No.: 1714  
Examiner: Cephia D. Toomer

Commissioner for Patents  
BOX CPA  
Washington, D.C. 20231

"PATENT"

#8  
5/8/02  
19

CONTINUED PROSECUTION APPLICATION (CPA)  
(37 C.F.R. § 1.53(d))

NOTE: A continued prosecution application can only be filed for a divisional or continuation of a prior nonprovisional application and CANNOT be filed for a continuation-in-part application. 37 C.F.R. § 1.53(d)(1).

NOTE: Facsimile transmission can be used to obtain a date of transmission for this correspondence. 37 C.F.R. § 1.8(b)(3).

WARNING: A continued prosecution application "is a request to expressly abandon the prior application" as of its filing date. 37 C.F.R. § 1.53(d)(2)(v).

WARNING: While the filing of a continued prosecution application is the specific reference required by 35 U.S.C. § 120 to every application assigned the application number, identified in such request, no amendment in the application may delete the specific reference to any prior application (e.g., for patent term purposes). 37 C.F.R. § 1.53(d)(7).

CERTIFICATION UNDER 37 C.F.R. 1.8(a) AND 1.10

(when using Express Mail, the Express Mail label number is mandatory; Express Mail certification is optional)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10

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Teresa L. Lachowski  
(type or print name of person certifying)



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TC 1700

1. This is a request for the filing of a

☒ Continuation

☐ Divisional

Continued prosecution application under 37 C.F.R. § 1.53(d) of the above-identified prior nonprovisional application.

It is further requested that this continued prosecution application utilize the file jacket and contents of the prior application, including the specification, drawings, and oath or declaration from the prior application, to constitute this new application, and that the application number of the above-identified prior application be assigned for identification purposes. (37 C.F.R. § 1.53(d)(2)(iv)).

It is also requested that the above-identified application be expressly abandoned as of the filing date accorded this continued prosecution application. (37 C.F.R. § 1.53(d)(2)(v)).

2. With respect to the above-identified nonprovisional application, this continued prosecution application is being filed:

A. ☒ before the earliest of the:

☒ termination of the proceedings on the prior application (37 C.F.R. § 1.53(d)(1)(ii)(C)).

☐ payment of the issue fee thereon (37 C.F.R. § 1.53(d)(1)(ii)(A)).

☐ abandonment of the prior application (37 C.F.R. § 1.53(d)(1)(ii)(A)).

B. ☐ After the payment of the issue fee -- but a petition under § 1.313(b)(5) has been Granted in the prior application. (37 C.F.R. § 1.53(d)(1)(ii)(A)).

C. ☒ The term for response for taking action in the prior application expires on 5/11/02.

☐ An extension of time in the prior application:

☐ is filed concurrently in the prior application

☐ has been filed on \_\_\_\_\_

3. This continued prosecution application names as inventors:

☒ the same inventors named in the prior application on the date this continued prosecution application under 37 C.F.R. § 1.53(d) is being filed. (37 C.F.R. § 1.53(d)(4)).

☐ inventors fewer than all the inventors named in the prior application. (37 C.F.R. § 1.53(d))

☐ Please delete the following name(s) as inventor(s): \_\_\_\_\_

4. ☒ Enter the unentered amendment previously filed on 3/11/02 under 37 C.F.R. § 1.116 in the prior nonprovisional application.

5. ☐ A preliminary amendment is enclosed.

6. Information Disclosure Statement (IDS) is enclosed:

a. ☐ PTO-1449

b. ☐ Copies of IDS Citations

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## 7. Fee Calculation

CLAIMS AS FILED					Basic Fee 37 C.F.R. § 1.16(a) \$740.00	
Number filed	Number Extra		Rate			
Total Claims (37 C.F.R. § 1.16(c))	<u>9</u> - 20 = <u>—</u>	X	\$ 18.00 =		\$	<u>0</u>
Independent Claims (37 C.F.R. § 1.16(b))	<u>2</u> - 3 =	X	\$ 84.00 =		\$	<u>0</u>
Multiple Dependent Claim(s), if any (37 C.F.R. § 1.16(d))	+		\$280.00		\$	<u>0</u>
Filing Fee Calculation					\$	<u>740.00</u>

## 8. Fee Payment Being Made at This Time

- ☒ Filing Fee \$ 740.00
- ☐ Recording Assignment (\$40.00 -- 37 C.F.R. § 1.21(h)) \$
- ☐ Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached. (\$130.00 -- 37 C.F.R. § 1.47 & 1.17(i)) \$
- Total Fees \$ 740.00

## 9. Method of Payment of Fees

- ☒ The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account Number 05-1330:
- ☐ Fees required under 37 C.F.R. 1.16, 1.17, and 1.18.

Date: April 25, 2002

Registration Number: 27,766

Telephone Number: (908) 730-3629

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Joseph J. Allecca 2002

Signature of Practitioner

**TC 1700**

JOSEPH J. ALLECCA

(Attorney or Agent of Record)

## Correspondence Address:

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"PATENT"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alan G. Blahey et al ) Before the Examiner  
U. S. Serial No. 09/806,873 ) Cephia D. Toomer  
Filed: April 3, 2001 ) Confirmation No. 6495  
Long Life Gas Engine Oil and Additive System ) Group Art Unit 1714

Commissioner for Patents  
Washington, DC 20231

Sir:

AMENDMENT

B

In response to the Office Letter of December 31, 2001 (Paper No. 5) please amend the claims as set forth in the attachment captioned "Amended Claims With Markings".

DETAILS OF AMENDMENT

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Applicants amended claim 1 and 6 to indicate that the base oil has a viscosity of 9 to 13 cSt at 100°C. Support for this amendment can be found at page 4, line 22.

I hereby certify that I have a reasonable basis for believing that this correspondence will be deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231, on MARCH 11, 2002.

Date of Deposit

KATHLEEN A. KUNA

Name of attorney or agent

Kathleen A. Kuna

Signature

MARCH 11, 2002

Date of Signature



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Claims 1 and 6 were also amended to indicate that the base oil is a natural or synthetic oil or mixture thereof (see original claims 2 and 7) and that the natural oil may be hydrocracked or solvent extracted (see the examples).

Claims 1 and 6 also were amended to indicate that the oils are low ash detergents (the oil of the examples falls within the low ash range of the Table on page 2 and the preferred detergent system mentioned in the first full paragraph on page 11).

New claims 10 and 11 are drawn to the hydrocracked and solvent extracted mixed base oil of the examples.

Claims 2 and 7 are cancelled and claims 4 and 9 were amended to change their dependency.

New claims 12 and 13 are drawn to the detergent system set forth at page 11, first full paragraph.

Clean copies of the amended and new claims are enclosed.

#### REMARKS REGARDING REJECTIONS

The Examiner rejected the claims under 35 U.S.C. 103(a) based on Inoue. Applicants respectfully request the Examiner to reconsider and withdraw that rejection.

As amended the composition and method requires use of a low ash gas engine oil detergent system which is not suggested or disclosed by Inoue. Indeed, the

ash of the composition in Applicants' examples is about 0.45 wt% whereas Inoue specifies from 0.5 to 1.2 wt% of sulfated ash. Also, Inoue requires a relatively large amount of VI improver to provide his engine oil with a multi-viscosity over the range of 5.6 to 12.5 mm<sup>2</sup>/s at 100°C. In contrast applicants employ only a minor amount of VI improver. Thus, the applicants' specified amount of the VI improver will not provide a multi viscosity composition but rather only increases the viscosity.

Finally, Inoue not only requires a specified amount of aromatics in his base oil, he also requires the presence of all his ingredients in the amount specified to achieve a synergistic effect. It would not be obvious then that a composition employing an oil of different viscosity, containing a different amount of VI improver and a low ash gas engine oil detergent would function satisfactorily. Clearly, the opposite is suggested by Inoue.

In view of the foregoing applicants request the Examiner to withdraw her rejection based on Inoue.

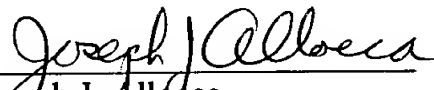
The Examiner rejected the claims under 35 U.S.C. § 103(a) based on Venice. Applicants respectfully request the Examiner to withdraw that rejection.

Applicants' claims require use of a gas engine detergent having a TBN of about 50 to 300 in an amount to provide a low ash composition, e.g., about 0.45 wt% ash. Vienna, among other distinctions, requires in his hydraulic fluid a neutral calcium sulfate at 7 to 12 vol% level which clearly would provide an ash in excess of that in a

low ash composition. Clearly there is no suggestion on the face of the reference of applicants' gas engine oil composition having a basic gas engine detergent in an amount to provide a low ash composition.

Applicants believe the claims as amended are now in condition for allowance and respectfully request the Examiner to pass the case to issue.

Respectfully submitted,

  
\_\_\_\_\_  
Joseph J. Allocca  
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☒ Pursuant to 37 CFR 1.34(a)

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Dvorak:kak  
March 7, 2002